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Phillip Ace McCoppin

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EXAMINER

BAIRD, EDWARD J

ART UNIT

PAPER NUMBER

3695

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/747,612	<b>Applicant(s)</b> MCCOPPIN ET AL.	
	<b>Examiner</b> Ed Baird	<b>Art Unit</b> 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Status of Claims*

1. Applicant has amended **claims 1, 13 and 25**. No claims have been added or canceled. Claims 6 and 26 were canceled prior to the previous office action. Thus, claims 1-5 and 7-25 remain pending in this application.

### *Response to Arguments*

2. Applicant's arguments and amendments filed on **01 March 2011** with respect to
- rejections of claims 1-5 and 7-25 under U.S.C. § 112, 1<sup>st</sup> paragraph,
  - rejections of claims 1-5 and 7-25 under U.S.C. § 112, 2<sup>nd</sup> paragraph,
  - rejections of claims 1-5 and 7-25 under 35 U.S.C. § 103(a),
- have been fully considered.
3. Examiner acknowledges amendments to claims 1, 13 and 25 and arguments regarding 35 U.S.C. § 112, 1<sup>st</sup> paragraph rejections and, in turn, withdraws rejections.
4. Examiner acknowledges amendments to claims 1, 13 and 25 and arguments regarding 35 U.S.C. § 112, 2<sup>nd</sup> paragraph rejections and, in turn, withdraws rejections.
5. Applicant's arguments filed with respect to **claims 1-5 and 7-25** regarding the 35 U.S.C. § 103(a) rejections have been fully considered but they are not persuasive.
6. Applicant argues **Lawrence** does not teach "guaranteed funding" of a financial transfer of funds as specifically claimed [Remarks page 14, 1<sup>st</sup> full paragraph]. Further, Applicant disagrees with Examiner's *implicating insured banks with self-funded/ guaranteed wire transactions* [Remarks page 14, 3<sup>rd</sup> full paragraph]. However, Examiner respectfully disagrees.
7. **Lawrence** teaches *Funds Transfer Provider* which is an entity with resources, facilities, authorizations or other factors required to effect an electronic transfer of funds [0029]. He teaches a funds transfer institution as including a government entity, such as the U.S. Federal

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Reserve's *Fedwire* or a private institution, such as Western Union, *CHIPS* or *SWIFT* [Id.]. He also teaches ***Risk Management Clearinghouse*** (RMC) which gathers data, such as, for example, public data, and relates the data to risk variables for the purpose of managing risk associated with a risk variable [0030]. Embodiments can also include a RMC that provides a risk quotient or other valuation of an amount of risk associated with a particular risk variable, set of risk variables, transaction, institution, individual, jurisdiction, organization, entity or other risk subject. Examiner maintains that a ***Risk Management Clearinghouse*** is indicative of Applicant's *self-funded/ guaranteed wire transactions* in as much as it allows transactions to settle.

8. Applicant argues **Lawrence** does not teach *coupling FEDWIRE transfers with (these) other types of transfers to provide guaranteed funding or funds transfers from the U.S. to non-U.S. entities* [Remarks page 14, 2<sup>nd</sup> full paragraph]. However, Examiner respectfully disagrees, in as much **Lawrence** discloses: "depository institution that maintains a reserve or clearing account with a Federal Reserve Bank may use Fedwire to send payments to, or receive payments from, other account holders directly" [0023]. Examiner maintains that *using a reserve or clearing account effectively guarantees fund transfers* as claimed by Applicant (claim 1).

9. Applicant remarks "Examiner equates Applicants' claimed analyzing that includes identifying any necessary intermediary and processing institutions required to process the" [Remarks page 15]. Examiner notes that Applicant's argument is incomplete.

10. Applicant makes bold assertion that **Barbara** does not teach *providing guaranteed, final and irrevocable self-funding of the transaction to the Receiver Financial Institution that prevents any deficiencies in the self-funding* [Remarks page 16]. However, Examiner respectfully disagrees on several accounts.

11. *First*, based on amended claim language, the limitation reads "*prevents deficiencies in the self-funding*", not "*prevents any deficiencies in the self-funding*" (emphasis on any). *Second*, Applicant has not clearly presented an argument against **Barbara** and cited passages thereof. *Third*, Examiner maintains that **Barbara** teaches further the concept of *self-funded/guaranteed wire transactions* as maintained in the rejection below.
12. Applicant make further bold assertions that neither **Barbara** nor **Lawrence** teaches independent claims 1 and 13 [Remarks page 16-18] and claim 25 [Remarks page 19 and 20]. Examiner maintains that Applicant presents no clear arguments in these remarks.
13. Although Applicant does not agree with the "propriety of the reliance upon **Official Notice** with respect to stopping processing for procedures that are non-compliant with government regulations" [Remarks page 19], Examiner provides **Kishi et al** (US Pub. No. 2001/0053224) as evidence that this feature is old and well known.

**Kishi** teaches method to prevent the *non-compliant use* of sold digital information including generating usage conditions for the information for sale, and *authenticating* a recording medium [0020] and [0022]. He discloses *license management* capability [0036] and *license generating* capability [0065]. He discloses displays an **error message** when authentication is not successfully, and accordingly **ending the selling process** [0104].

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to modify **Lawrence's** disclosure to include *displaying an error message, and ending the selling process* as taught by **Kishi** to prevent non-compliant use of sold digital information - **Kishi** [0024].

#### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-3, 5, 7-15, and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lawrence** (US Pub. No. 2003/0233319) in view of **Barbara et al** (US Pub. No. 2003/0105710).

16. Regarding **claims 1 and 13**, **Lawrence** teaches:

- receiving, in one or more computer processors at a Receiver Financial Institution, a single authorizing foreign financial transaction payment instruction from a Client Bank over a computer network - *see at least* [0065] *and* [Figure 2] in a format associated with a domestic settlement funds transfer system used for funding domestic credit transfer transactions that provides guaranteed transaction self-funding of the foreign financial transaction payment to the Receiver Financial Institution, said guaranteed transaction self-funding ensuring against deficiencies in the self-funding - *see at least* [Abstract], [0022]-[0024] *and* [Figure 1]. Examiner interprets financial institution as including Applicant's Client Bank and Receiver Financial Institution. Examiner notes that these financial institutions include "*any insured bank*"; thus "*any insured bank*" is indicative of Applicant's *guaranteeing transactions*;
- analyzing, by the one or more computer processors, the received single authorizing foreign financial transaction payment instruction - *see at least* [0030], [0032] *and* [0057]. Examiner interprets a *risk management clearing house (RMC)* which "gathers data . . . and relates the data to risk variables for the purpose of managing risk associated with a risk variable" as analogous to Applicant's *analyzing financial transaction payment instructions*,

- wherein said analyzing comprises identifying any necessary intermediary and processing financial institutions required to process the foreign financial transaction payment to the foreign financial transaction beneficiary [0032]; and
- responsive to said analyzing, generating, in the one or more computer processors, foreign financial transaction payment instructions for at least one financial institution located in the foreign country and transmitting the foreign financial transaction payment instructions over the computer network - *see at least* [0078] *and* [Figure 5], the foreign financial transaction payment instructions including data in a funds transfer messaging service format that is compatible with both the Receiver Financial Institution and the at least one financial institution - *see at least* [0031] *and* [0033]. Examiner notes that *financial institutions* [0024] include foreign banks and foreign financial agencies as claimed by the Applicant.

**Lawrence** does not explicitly disclose:

- wherein said guaranteed, self-funding of the foreign financial transaction payment comprises both the Receiver Financial Institution and the Client Bank being members of the domestic settlement funds transfer system in which said members are required to: (1) have funds for the foreign financial transaction payment available in the domestic settlement funds transfer system, and (2) settle transactions daily initiated using the domestic settlement funds transfer system.

However, **Barbara** teaches a method and system for on-line payments which enables the making of payments using any of a credit card or a checking account or savings account to facilitate an on-line transaction [0006]. She further discloses *funds transfer capability* which allows a customer at a terminal to use the customer's transaction account to transfer funds, for example, between *eligible accounts* [0031]. In addition, the customer can use the transaction

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account to transfer funds, for example, via selection of a *self-fund mechanism* which will provided an instant *availability of funds* [Id.]. This also enables the customer to move money from the customer's checking account in one bank to the customer's checking account *in a different bank* [0139]. In turn, the customer can use one account as collateral to ensure there are funds available in another account [Id.]. Examiner notes that this *self-funding mechanism* is analogous to Applicant's *self-funding of the transaction* in that different accounts in different banks are used as back-up to ensure an available of funds.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to modify **Lawrence's** disclosure to include a *self-funding mechanism* as taught by **Barbara** because a user can use one account as collateral to ensure that there are funds available in another account even when the accounts are in different banks - **Barbara** [0031 and [0139].

Examiner notes that the use of a *domestic settlement funds transfer system* and *settling transactions daily* are merely statements of intended use and are not given patentable weight. A recitation of intended use or purpose of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use or fulfilling said purpose, then it meets the claim. (See also MPEP § 2111.04).

17. Regarding **claims 2 and 14**, **Lawrence** teaches:

- wherein the settlement funds transfer system comprises a U.S. Federal Reserve Bank funds transfer system that carries out domestic funds transfers - *see at least* [0029],



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- wherein the (single authorizing) foreign financial transaction payment instructions cause both an automatic credit and an automatic debit of associated accounts to be made upon receipt - *see at least* [0041] *and* [0042].
18. Regarding **claims 3 and 15**, **Lawrence** teaches:
- wherein the funds transfer messaging service format that is compatible with both the Receiver Financial Institution and the at least one financial institution is compatible with a world-wide financial messaging network interfaced with the computer network and comprising standardized messaging services and interface software running in the one or more computer processors that initiates international payments - *see at least* [0002], [0023] *and* [0029]. Examiner notes that SWIFT (“Society for Worldwide Interbank Financial Telecommunication”) is an example of Applicant’s *world-wide financial messaging network*.
19. Regarding **claims 5 and 17**, **Lawrence** teaches the Client Bank as a domestic bank [0024].
20. Regarding **claims 7 and 19**, **Lawrence** teaches:
- the foreign financial transaction payment instructions are received via a network interface with the domestic settlement funds transfer system, said network interface being configured to provide access to a U.S. Federal Reserve Bank funds transfer system useful for carrying out domestic funds transfers - *see at least* [0024].
21. Regarding **claims 8 and 20**, **Lawrence** teaches:
- transmitting the foreign financial transaction payment instructions to the at least one financial institution - *see at least* [0024].
22. Regarding **claims 9 and 21**, **Lawrence** teaches:

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- the at least one financial institution includes a branch of the Receiver Financial Institution that generated and transmitted the foreign financial transaction payment instructions - *see at least* [0026] *and* [0027].
23. Regarding **claims 10 and 22**, **Lawrence** teaches:
- the at least one financial institution includes a member of a non-Federal Reserve Bank electronic payments system - *see at least* [0024].
24. Regarding **claim 11**, **Lawrence** teaches:
- the at least one financial institution includes a member of a U.S. Federal Reserve Bank funds transfer system that carries out domestic funds transfers - *see at least* [0023],
  - wherein the foreign financial transaction payment instructions cause both an automatic credit and an automatic debit of associated accounts to be made upon receipt thereof receipt - *see at least* [0041] *and* [0042].
25. Regarding **claims 12 and 24**, **Lawrence** teaches:
- the at least one financial institution includes a correspondent bank that is connected to the Receiver Financial Institution that generated and transmitted the foreign financial transaction payment instructions via a world-wide financial messaging network - *see at least* [0023] *and* [0029]
  - the world-wide financial messaging network comprises standardized messaging services and interface software (running in at least one processor that initiates - claim 24) used to initiate international payments - *see at least* [0067]-[0069],
  - the correspondent bank handling business in a particular geographic area - *see at least* [0002], [0051] *and* 0059].
26. Regarding **claims 18**, **Lawrence** teaches

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- the single authorizing foreign payment instruction received from the client bank cause both an automatic credit and an automatic debit of associated accounts to be made upon receipt thereof - *see at least* [0041] *and* [0042].

27. Regarding **claim 23**, **Lawrence** teaches:

- the at least one financial institution includes a member of a U.S. Federal Reserve Bank funds transfer system **that carries** out domestic funds transfers - *see at least* [0023].

28. Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lawrence** in view of **Barbara** and in further view of **SWIFT.com** ("MT 103 migration – a success for the whole community", home page stories archive 2003, posted 11/21/2003).

29. Regarding **claims 4 and 16**, **Lawrence** and **Barbara** teaches all the items of claims 2 and 14, the claims upon which these claims depend, respectively, but do not teach foreign financial transaction payment instructions which comply with SWIFT MT 103 specifications (i.e. messaging standards).

However, **SWIFT.com** teaches about foreign financial transaction payment instructions which comply with SWIFT MT 103 messaging standards. **SWIFT.com** discloses "The weekend of 15-16 November saw two significant events in SWIFT's history. The first was the removal of the MT 100, SWIFT's most-used message, from the network. To enable this to happen, migration to the MT 103 needed a successful completion and this was achieved with a 98% migration rate on the last working day before the deadline" [2<sup>nd</sup> paragraph].

Therefore, it would have been obvious to a person having an ordinary skill in the art at the time of the instant invention to modify **Lawrence's** disclosure to include *SWIFT MT 103 specifications* as disclosed by **SWIFT.com** because its use would increase certainty,

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transparency, and automation (STP) of customer transfers as well as reduced cost, reduced risk, and conform to worldwide regulatory requirements.

30. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Lawrence** in view of **Barbara** in further view of **Official Notice**.

31. **Claim 25** is substantially similar to claims 1 and 13 with added limitations. **Lawrence** also teaches:

- ensuring compliance of the funds transfer instructions with one or more government requirements - *see at least* [0026] *and* [0050]. Examiner interprets *regulatory requirements* as analogous to Applicant's *government requirements*.
- if the funds transfer instructions are compliant with the one or more government requirements [0050], ensuring, via the computer system, that any required data fields in the funds transfer instructions meet all data requirements of the settlement funds transfer system - *see at least* [0026] *and* [0030].

**Lawrence** does not explicitly disclose:

- if the funds transfer instructions meet said data requirements, crediting an account of the client bank established for foreign payments with an amount associated with the funds transfer instructions:

However, **Barbara** teaches crediting an account of the client bank to a foreign bank with the funds transfer instructions - *see at least* [0093] *and* [0139].

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to modify **Lawrence's** disclosure to include *crediting an account of the client bank to a foreign bank* as taught by **Barbara** because a customer can use the system to make person-to-person payments to other recipients in different countries - **Barbara** [0093].

Neither **Lawrence** nor **Barbara** explicitly discloses:

- ending processing of the funds transfer *instructions* [sic] when funds transfer instructions are not compliant with government requirements, and
- ending processing of the funds transfer *instructions* [sic] and generating an error message if data requirements are not met.

However, Examiner takes **Official Notice** that one having ordinary skill in that art at the time of the instant invention would *end processing a funds transfer when funds transfer instructions are not compliant with government* because otherwise the transfer would be in violation of government requirements.

Examiner takes **Official Notice** that one having ordinary skill in that art at the time of the instant invention would *end processing a funds transfer and generate an error message when data requirements are not met* because the transfer process can not be performed properly.

### **Conclusion**

32. The prior art of record and not relied upon is considered pertinent to Applicant's disclosure:

- **Sarcenin**: "Method and system for a virtual safe", (US Patent No. 6,941,285).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ed Baird whose telephone number is (571)270-3330. The examiner can normally be reached on Monday - Thursday 7:30 am - 5:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles R. Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ed Baird/  
Examiner, Art Unit 3695

/Narayanswamy Subramanian/  
Primary Examiner, Art Unit 3695